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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,399	01/04/2005	Hideharu Iwasaki	263048US0XPCT	6829

22850 7590 11/30/2009  
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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MCCRACKEN, DANIEL

ART UNIT	PAPER NUMBER
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1793

NOTIFICATION DATE	DELIVERY MODE
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11/30/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/519,399	<b>Applicant(s)</b> IWASAKI ET AL.	
	<b>Examiner</b> DANIEL C. MCCracken	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 7/1/2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 35,42 and 52-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35,42 and 55-61 is/are allowed.
- 6) ☒ Claim(s) 52-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

Citation to the Specification will be in the following format: (S. # : ¶/L) where # denotes the page number and ¶/L denotes the paragraph number or line number. Citation to patent literature will be in the form (Inventor # : LL) where # is the column number and LL is the line number. Citation to the pre-grant publication literature will be in the following format (Inventor # : ¶) where # denotes the page number and ¶ denotes the paragraph number.

***Status of Application***

Claims 35, 42, and 52-61 are pending. Claims 1-34, 36-41 and 43-51 are acknowledged as cancelled. Claims 35 and 55-61 were previously indicated as allowable. These claims - while not truly "dependent" claims have been amended to incorporate the product limitations of the claims they referenced. The amendments will be entered.

Certain remarks were made with respect to rejoinder. (Remarks of 7/1/2009 at 12). No withdrawn claims are pending. As such, these remarks were not understood.

***Response to Arguments*****Claim Rejections – 35 U.S.C. §112**

With respect to the rejection of Claim 43 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, Applicants have *now* pointed to a portion that supports the limitation. (Remarks of 7/1/2009 at 9). The rejection is WITHDRAWN.

Claim Rejections – 35 U.S.C. §102

**I.** With respect to the rejection of Claims 33-34, 36-41, 43-51 under 35 U.S.C. 102(b) as being anticipated by Nakamura, et al., *Influence of physical properties of activated carbons on characteristics of electric double-layer capacitors*, J. Pwr. Sources 1996; 60: 225-231 (hereinafter “Nakamura at \_\_\_”), cancellation of these claims moots the rejection. The rejection is WITHDRAWN.

**II.** With respect to the rejection of Claims 52-54 under 35 U.S.C. 102(b) as being anticipated by US 5,891,822 to Oyama, et al., Applicants traversal is on the grounds that “Applicants respectfully submit that nowhere does Oyama disclose or suggest an acidic wash containing an oxidizing agent as according to Claim 52.” (Remarks of 7/1/2009 at 10). This is not persuasive. The acid is the “oxidizing agent,” i.e. the thing that is reduced. The rejection is MAINTAINED, updated to address amendments.

Claim Rejections – 35 U.S.C. §103

**I.** With respect to the rejection of Claims 33-34, 36-41, 43-51 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nakamura, et al., *Influence of physical properties of activated carbons on characteristics of electric double-layer capacitors*, J. Pwr. Sources 1996; 60: 225-231, cancellation of these claims moots the rejection. The rejection is WITHDRAWN.

**II.** With respect to the rejection of Claims 52-54 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 5,891,822 to Oyama, et al., Applicants rely on their remarks under the anticipation rejection, addressed above. The rejection

Art Unit: 1793

is MAINTAINED, updated to address amendments. Applicants citation of “the Office’s own discussion” of 103 guidelines is noted. (Remarks of 7/1/2009 at 10). Applicants are directed to MPEP 2112 III. for a discussion of 102/103 rejections, as it appears as if the nature of the rejection is not understood. This rejection has nothing to do with *KSR*. It has everything to do with principles of inherency as set forth in the MPEP.

**III.** With respect to the rejection of Claim 42 under 35 U.S.C. 103(a) as being unpatentable over US 5,891,822 to Oyama in view of US 2,567,468 to Berl, Applicants traversal is that the references do not teach the claims *as currently amended*. This is persuasive. The rejection is WITHDRAWN.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 52-54 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 5,891,822 to Oyama, et al.

With respect to Claim 52, Oyama teaches alkali activation of vinyl chloride resins. (Oyama 8: 14-25). The activated carbon is washed with an acid. (Oyama 8: 31). The activated carbon is mixed with a conductive material (Oyama 8: 39) and a binder (Oyama 8: 41) to make an electrode (Oyama 8: 44-45). As to Claim 53, KOH is recited. (Oyama 8: 22). As to Claim 54, HCl is taught. (Oyama 8: 31). This is the “oxidizing agent.” It is expected that the HCl is in an aqueous solution, as Oyama recites “washing” and HCl is a gas at room temperature, so it is

Art Unit: 1793

typically used in aqueous form to facilitate handling, etc. This is the evidence offered to show inherency. Likewise, given the claimed process steps are taught, it is expected that the product limitations are inherently produced. “[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency’ under 35 U.S.C. 102, on prima facie obviousness’ under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted].” The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).

#### ***Allowable Subject Matter***

Claims 35, 42 and 55-61 allowed.

#### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 1793

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL C. MCCracken whose telephone number is (571)272-6537. The examiner can normally be reached on Monday through Friday, 9 AM - 6 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley S. Silverman can be reached on (571) 272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daniel C. McCracken/  
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Examiner, Art Unit 1793  
DCM

/Stanley S. Silverman/  
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